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FACSIMILE TRANSMITTAL FORM	Application Number	09/728697
	Confirmation Number	5552
	Filing Date	December 1, 2000
	First Named Inventor	Stagg, Timothy V.
	Examiner Name	
Fax: 571-273-8300	Attorney Docket Number	54186US017
Total Number of Pages in This Submission: 7		
Date: July 21, 2006	Attorney for Applicant: Thomas M. Spielbauer	

ENCLOSURES (check all that apply)

☐ Fee Transmittal Form ☐ Issue Fee Transmittal ☐ Amendment Transmittal	☐ Petition	☒ Appeal Communication to Board of Appeals and Interferences
☐ Amendment/Reply ☐ After Final ☐ Affidavits/Declaration(s)	☐ Petition to Convert a Provisional Application	☐ Appeal Communication to Technology Center (Appeal Notice, Brief, Reply Brief)
☐ Extension of Time Request	☐ Power of Attorney, Revocation	☐ Proprietary Information
☐ Express Abandonment Request	☐ Change of Correspondence Address	☐ Status Letter
☐ Information Disclosure Statement	☐ Terminal Disclaimer	☐ Other Enclosures:
☐ Response to Missing Parts/ Incomplete Application ☐ Response to Missing Parts under 37 CFR § 1.52 or 1.53 ☐ Response to Missing Parts under 35 USC 371 in US Designated/ Elected Office (DO/EO/US)	☐ Request for Refund ☐ Request for Continued Examination (RCE) Transmittal	
☐ Drawings	☐ After Allowance Communication to Technology Center	

REMARKS:

REQUEST FOR REHEARING UNDER 37 CFR § 41.52(a)(1)
EXPEDITED PROCEDURE
EXAMINING GROUP:1761

32692
Customer Number

Patent
Case No.: 54186US017

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

First Named Inventor:	STAGG, TIMOTHY V.	
Application No.:	09/728697	Confirmation No.: 5552
Filed:	December 1, 2000	
Title:	TEAR CONTROL CLOSING TAPE AND CONTAINER WITH TEAR CONTROL CLOSING TAPE	

REQUEST FOR REHEARING UNDER 37 CFR § 41.52(a)(1)

Mail Stop Amendment
Commissioner for Patents
P.O. Box 1450
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I hereby certify that this correspondence is being:
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☑ transmitted by facsimile on the date shown below to the United States Patent and Trademark Office at 571-273-8300.

7-21-06
Date

Jenny Thompson
Signed by: Jenny Thompson

Dear Sir:

This is a Request for Rehearing under 37 CFR 41.52 (a)(1) from the Decision on Appeal issued by the Board of Patent Appeals and Interferences mailed May 31, 2006.

This Request is believed to be timely submitted. It is believed that no fee is due; however, in the event a fee is required, please charge the fee to Deposit Account No. 13-3723.

Brief Summary of the Points Misapprehended

I. The Board's decision repeatedly relies upon the erroneous assertion that "there is no dispute that Riddell discloses the use of the presently claimed tearable tape strip."

The Board's decision relies on the assertion that Appellants have not presented arguments distinguishing the presently claimed tearable tape strip from that purportedly disclosed in Riddell. This assertion is false, as Appellant's Reply Brief plainly distinguishes the "opening means 5 of Riddell" from "the 'tearable tape strip' limitations of claims 1, 17, and 38." As the Board's decision clearly relied upon this misunderstanding, Appellants respectfully submit that the requisite criterion for granting a rehearing exists and request that such a rehearing be granted.

II. The Board's decision improperly relies on Appellants' own specification to establish obviousness.

The Board improperly relied on the results reported in Appellants' specification as the sole support for its conclusion that films characterized by a puncture-propagation tear resistance of at least 20 N/ply are "low tear strength" films as described by Riddell. (See the Decision, page 6.) It is well established that the use of that which the inventor taught against its teacher is improper. Appellants respectfully submit that the Board's apparent misapprehension of this governing legal precedent further demonstrates that a rehearing is necessary and respectfully request that such a rehearing be granted.

III. The Board's decision fails to establish the requisite motivation to combine Underwood and Leseman.

The Board's decision relies in part on Leseman to overcome an admitted deficiency in Underwood; however, the Board has failed to make the requisite showing that some objective teaching of the prior art or some knowledge generally available to one of ordinary skill in the art would teach, suggest, or motivate one to combine these references. Appellants respectfully submit that the Board's apparent misapprehension of this governing legal precedent further demonstrates that a rehearing is necessary and respectfully request that such a rehearing be granted.

Arguments in Support of Request for Rehearing

I. The Board's decision repeatedly relies upon the erroneous assertion that "there is no dispute that Riddell discloses the use of the presently claimed tearable tape strip."

On page 5 of the Board's Decision on Appeal (the "Decision"), the Board asserts "[t]here is no dispute that Riddell discloses the use of the presently claimed tearable tape strip ...." Similarly at page 6, the Board asserts that "[w]e again note that appellants have not made any argument that the claimed tearable tape strip is somehow structurally different than the one fairly taught by Riddell." These assertions are false.

In their Reply Brief, Appellants distinguished the structure of the opening means of Riddell from the tearable tape strip of the present invention. (See page 3.) Appellants submit that these structural differences necessarily lead to functional differences. For example, as stated in Appellants' Reply Brief, Riddell describes two distinct elements (guide tape 8 and pull strip 9) affixed to opposite sides of a film. According to Riddell, as the pull strip is pulled out, "the side wall 7 is sheared along two edges." (Col. 3, lines 20-23, emphasis added.) In contrast, the tearable tape strip of the present invention is a unitary structure applied to one side of the film. Applicants submit that, without elements on opposite sides of the film no shearing can occur. Rather, the tearable tape strip of the claimed invention is configured to controllably tear an opening. (See, e.g., claim 1.)

Therefore, to the extent the Board's decision relied on the erroneous assertion that there is no dispute that Riddell discloses the use of the presently claimed tearable tape strip, Appellants respectfully request reconsideration.

II. The Board's decision improperly relies on Appellants' own specification in establishing obviousness.

The Board relies on results reported in Appellants' specification as the sole support for its conclusion that films characterized by a puncture-propagation tear resistance of at least 20 N/ply are "low tear strength" films as described by Riddell. Specifically, the Board alleges that

> appellants seem to overlook that Riddell actually teaches that the tear strength of the polyethylene film is only sufficiently low to permit opening of the package, which, manifestly, is a property shared by appellants' "tear-resistant film." Clearly, tear-resistant films within the scope of the appealed

> claims must also have a sufficiently low tear strength to permit opening of the package. ... We again note that appellants have not made any argument that the claimed tearable tape strip is somehow structurally different than the one fairly taught by Riddell.

(Decision on Appeal, page 6.) Thus, it appears that the Board believes that any film capable of being opened by Appellants' tape must also be capable of being opened by the tape of Riddell.

First, this line of reasoning assumes that the claimed tape is identical to that described by Riddell. As discussed above, this is incorrect and, thus, any attempt to use the results obtained with the claimed tape to define the expected performance of the tape of Riddell is clearly improper. Second, even assuming, *arguendo*, the tapes were similar, it is well established that that use of that which the inventor taught against its teacher is improper. (See, e.g., In re Lee, 277 F.3d 1338, 1344, 61 USPQ2d 1430, 1434 (Fed. Cir. 2002).

Clearly if Riddell had asserted that its tear tapes could not be used with polyethylene, the Board would not have used Appellants' success with such films to establish obviousness. Similarly, where as here Riddell states that the film must have "sufficiently low tear strength to permit opening," the Board should not use Appellants' success in opening high tear strength films to establish that it would have been obvious to one of ordinary skill in the art that such films could be torn by the pull strip and guide tape of Riddell. ("That the inventors were ultimately successful is irrelevant to whether one of ordinary skill in the art, at the time the invention was made, would have reasonably expected success. [A] finding to the contrary represents impermissible use of hindsight-using the inventors' success as evidence that the success would have been expected." (Life Technologies, Inc. v. Clontech Laboratories, Inc., 224 F.3d. 1320, 1326, 56 USPQ2d 1186, 1191 (Fed. Cir. 2000). (Internal citations omitted).))

Therefore, to the extent the Board's decision relied on the improper use of Appellants' disclosure to establish the meaning of "low tear strength" in Riddell, Appellants respectfully request reconsideration.

III. The Board's decision fails to establish the requisite motivation to combine Underwood and Leseman.

With respect to the rejections based in part on Underwood, the Patent Office has acknowledged that Underwood fails to teach "the particular type of tear tape such as reinforced

strapping tape or filament reinforced tapes as recited in claims 1, 17, and 38." (See Examiner's Answer, page 7.) The Board's decision relies on Leseman to overcome this deficiency.

If the Board is suggesting that it would be obvious to replace the tape of Underwood with the tape of Leseman, then the Board has failed to present any evidence supporting a reasonable expectation of success. As discussed at page 12 of the Appeal Brief, Underwood specifically teaches that it is the tremendous tensile strength, decrease in elongation, and ability to heat seal without shrinking that make its film well-suited to act as a tear tape. (See Underwood at col. 6, lines 36-46; and col. 7, lines 27-31.) The Board has failed to show how the tape of Lesemen possesses any of these properties. Therefore, the Board has failed to show why one of ordinary skill in the art would be motivated to replace the tape of Underwood with the tape of Lesemen and, even if so motivated, would have a reasonable expectation of success in using the tape of Leseman as a tear tape.

If, instead, the Board is suggesting that the tape of Underwood be modified with the ribs of Leseman, then the Board has failed to provide the requisite motivation to do so. Underwood teaches the need for a highly oriented film such that "[w]hen a tear is initiated within the boundaries of the tear tape in the direction of orientation it will not deviate from a straight line by an amount not greater than ½ inch per foot of tear." (Col. 4, lines 62-69.) Underwood clearly states that its tear tape "readily passes the test herein described in that when the tear[is] initiated in the direction of orientation it does not deviate from a straight line more than ½ inch per foot of tear. (Col. 7, lines 63-66.) Therefore, the Board has failed to show why one of ordinary skill in the art would modify Underwood to improve cross-directional tear, when Underwood so clearly establishes that no such need exists.

In summary, the Board has failed to provide any motivation based on the references themselves or the knowledge of one of ordinary skill in the art for the proposed combination of Underwood and Leseman. (See, e.g., In re Fine, 837 F.2d 1071, 1074, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988).) Therefore, Appellants' respectfully request reconsideration of the rejections based on this combination of references.

Conclusion

Appellants respectfully submit that the requisite criterion for establishing the need for a rehearing has been met. Therefore, Appellants respectfully request that this Request for a Rehearing be granted. Appellants further request that the Board issue a decision overturning the final rejections of claims 1, 2, 4-9, 11, 13-18, 20-25, 27, 29-33, 35-39, 41, 42, 44-52, and 56.

Respectfully submitted,

July 21, 2006
Date

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